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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,880	06/29/2001	James A. Belmont	00054CIP	1018

7590 10/05/2004  
Michelle B. Lando, Esq.  
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Law Department  
157 Concord Road  
Billerica, MA 01821

EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/896,880

Applicant(s)

BELMONT, JAMES A.

Examiner

John A. McPherson

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 and 14-55 is/are pending in the application.
- 4a) Of the above claim(s) 18-48 and 52-55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5-12 and 14-18 is/are allowed.
- 6) ☒ Claim(s) 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action is responsive to the Amendment filed 6/17/04.
2. The Amendment filed 6/17/04 successfully overcomes the rejections set forth in paragraphs 4-6 of the Office Action mailed 1/5/04. Accordingly, these rejections are withdrawn.

The elected species, as currently amended, is allowable. Accordingly, the scope of examination has been expanded to include one of the nonelected species. This expanded examination necessitated the rejection presented below.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,110,994 to Cooke et al. (Cooke) in view of WO 99/51690 (WO '690). Cooke discloses a modified carbon product having attached a group having the formula -Ar-CO<sub>2</sub>-R or -(C<sub>n</sub>H<sub>2n</sub>-)-CO<sub>2</sub>-R, wherein R [corresponding to "Alk" in the present invention] is for example a C<sub>20</sub>-C<sub>50</sub> alkyl group, or a polymeric group, for example a polyolefin group. See the abstract; column 10, line 57 to column 11, line 27; and

Art Unit: 1756

column 23, lines 47-57. However, Cooke does not disclose a dispersion composition comprising the modified carbon product in a non-aqueous inkjet ink composition.

WO '690 teaches that modified pigment products having attached thereto an alkyl group or a polymer group, for example a polyolefin group, are useful in non-aqueous ink compositions, including inkjet applications. See the abstract; page 2, line 31 to page 3, line 9; page 3, lines 23-29; and page 5, line 25 to page 7, line 11; and page 12, lines 31-35. It would have been obvious to one skilled in the requisite art to form a non-aqueous inkjet composition, as taught by WO '690, utilizing the modified carbon product of Cooke because it is taught that modified pigment products having alkyl or polyolefin groups attached thereto have improved dispersibility and dispersion stability in a variety of materials, including non-aqueous inkjet compositions.

***Allowable Subject Matter***


4. Claims 1-3, 5-12 and 14-18 are allowed.
5. Claims 49-51 would be allowable if amended such that the pigment recited therein includes all the limitations of allowed generic claims 1, 5 or 6.
6. The scope of examination will be expanded to additional species if they are amended such that the pigment recited therein includes all the limitations of allowed generic claims 1, 5 or 6.

Art Unit: 1756

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John A. McPherson  
Primary Examiner  
Art Unit 1756

JAM  
10/1/04